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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/891,471 | 06/27/2001 | Masakazu Ogasawara | 041514-5130 | 1389 |

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MORGAN LEWIS & BOCKIUS LLP
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WASHINGTON, DC 20004

EXAMINER

PSITOS, ARISTOTELIS M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2653

DATE MAILED: 06/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/891,471

Applicant(s)

OGASAWARA ET AL.

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) all is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/4/03 has been entered.

Specification

The amendment to the title submitted on 4/4/03 has been entered. The examiner thanks applicants' cooperation in submitting such.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the

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examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi et al with the acknowledged "normalized" methodology in the "STANDARD DVD BOOK" and all further in view of Kasami et al.

The examiner interprets claim 1 as an apparatus using the methodology described in the acknowledged "standard DVD book" in order to determine the size of his photodetectors.

Hence, the examiner concludes applicants have not invented the methodology, but rather hardware, which relies upon such, accepted methodology to limit the size of the detectors.

The Hayashi et al document describes in this environment a minimum size of light spots, which fall within the range claimed.

The particular NA is not found in the base reference, nevertheless the use of such NA s in this environment is taught by the Kasami et al reference.

It would have been obvious to modify the base system of Hayashi et al with the accepted methodology and provide for appropriately sized photodetectors along with the additional NA limitation taught by Kasami et al. Those skilled in the art would certainly rely upon accepted methodologies to impact upon their engineering of the individual elements/photodetectors and selection of an appropriate NA for objective lens in this environment as further taught by Kasami et al.

Response to Arguments

Applicant's arguments filed 6/3/03 have been fully considered but they are not persuasive.

Applicants' arguments focus on:

a) *In re Nomiya* is not controlling because of different fact patterns. While Nomiya was decided due to the prior art figures in the application, no such figures are present herein. The examiner agrees that there are no figures in the present application labeled "prior art". Nevertheless, the specification at page 11, lines 12-28, which does bring in figure 8 (and hence fig. 8 is considered part of the acknowledged DVD standardization book). The examiner concludes that this DVD book establishes the formula recited in the present claim. Hence, this formula is part of the information contained in this

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DVD book, which is as acknowledged by applicants' "standardization book". In order for any book containing information that has been accepted as "standard", users in the specific environment must accept such. Hence the examiner is not persuaded with respect to this point.

b) The examiner reliance upon In re Peterson is also incorrect since the decision focused on narrowing of a range. The examiner is not persuaded because as acknowledged by applicants' in their description of this DVD book, a range between 100 and 144 squared micrometers is established. ✓ Applicants' claimed limitation is to a range of 10 – 50 squared micrometers. Hence the examiner concludes that this is a narrowing of an established range.

c) Neither of the reference to Hayashi et al and Kasami et al are related to normalization of a detector size, and hence do not remedy the deficiencies of the DVD standard book. The examiner didn't rely upon such references for teaching/disclosing the ability of normalization. The references were relied upon for what they teach/disclose.

In conclusion, the examiner maintains the grounds of rejection(s) as stated above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 above, and further in view of Official notice.

With respect to claim 7, this claim recites a result due to a conditional existence. That is when (c conditional) the detector size is limited to a value of 50 squared micrometers, a detecting circuit yields an output signal having less than or equal to 3% signal distortion. The examiner concludes that this conditional result is directed attributed to the size, i.e., the 50 squared micrometer. Hence, the examiner

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concludes that flowing from the selecting/narrowing of the size to the specific value (selected at 50 squared micrometers) any detection circuit coupled thereto will yield the appropriate distortion response.

The existence of detection circuitry in this environment is considered notoriously old and well-known and Official notice is taken thereof.

It would have been obvious to modify the base system of the references relied upon as stated in paragraph 1 above with respect to claim 1 and modify them by including a detection circuit, motivation is to provide a user with an appropriate signal. In this environment, the reproduced signal is what the user would like to see or hear or both.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Aristotelis M Psitos
Primary Examiner
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AMP
June 12, 2003